

IV. REMARKS/ARGUMENTS

This is a response to the Office Action of December 23, 2003. Claims 1-20 are pending in the application. Claims 1, 12 and 19 are independent claims. The Examiner has rejected claims 1-4, 12-14, and 19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,758,023 issued to Bordeaux (hereinafter "*Bordeaux*") in view of U.S. Patent No. 6,016,470 issued to Shu (hereinafter "*Shu*"). The Examiner rejected claims 5, 9, 16 and 18 under 35 U.S.C. § 103(a) as being unpatentable over *Bordeaux* in view of *Shu* and further in view of the Selounai publication entitled "Recognition of Arabic Phonetic Features Using Neural Networks and Knowledge-Based System: a Comparative Study" (hereinafter "*Selounai*"). The Examiner rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over *Bordeaux* in view of *Shu* and further in view of U.S. Patent No. 5,953,701 issued to Neti (hereinafter "*Neti*"). The Examiner rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over *Bordeaux* in view of *Shu* and further in view of U.S. Patent No. 6,546,369 issued to Buth (hereinafter "*Buth*"). Finally, the Examiner rejected claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over *Bordeaux* in view of *Shu* and further in view of U.S. Patent No. 6,490,557 issued to Jeppesen (hereinafter "*Jeppesen*").

A. Changes to the Drawings

Seven (7) replacement sheets of drawings are submitted with this response. These sheets, which include Figures 1-6, replace the original sheets including Figures 1-4. The changes to the drawings reflect the removal of embedded drawings from the specification. Original Figures 1-4 have been renamed as Figures 2-5, and the embedded drawings have been renamed as Figure 1 and Figure 6. No new matter is added.

B. Changes to the Specification

Several replacement paragraphs of the specification are submitted with this response. The replacement paragraphs reflect corrections necessary to refer to the new drawing Figures 1 and 6 that were originally embedded in specification of the application, and to refer to the renamed Figures 2-5. The replacement paragraphs further reflect correction of typesetting errors that caused Arabic characters to display incorrectly. No new matter is added.

C. Objections to the Claims

Claims 8 and 11 have been amended to overcome the Examiners objections to specific informalities. Dependent claim 8, which refers to a "transcription alphabet," has been amended to depend from claim 2, which recites the transcription alphabet to which claim 8 refers. Dependent claim 11 has been amended to refer to claim 10, consistent with the Examiner's correct treatment of the claim.

D. Rejections under 35 U.S.C. § 103(a)

The Examiner bears the initial burden of establishing a *prima facie* case of unpatentability. In the present case, this burden requires the Examiner to establish a *prima facie* case concerning the existence in the prior art of claim elements the Examiner recognizes are missing from *Bordeaux*. Specifically, to establish a *prima facie* case of obviousness, there must be some evidence of a suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art to modify the reference.¹ Where the references cited by the examiner fail to show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to

¹ MPEP 706.02(j). See also *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (explaining that the teachings or suggestion to make the claimed invention must be found in the prior art and not based upon the Applicant's disclosure.)

combine the relevant teachings of the references," the Examiner has not carried the burden of establishing a *prima facie* case of unpatentability.² Where the Examiner fails to establish a *prima facie* case, the rejection is improper and shall be reversed.³

The present invention involves systems and methods for acoustic transcription of speech using an orthographic system comprising a compact set of phonetics. The three pending independent claims — claims 1, 12 and 19 — include variations of the common element of a compact model for acoustically transcribing a language. As claimed, the compact model for acoustically transcribing a language includes a compact set of phonetic alphabets. As amended, the compact model for acoustically transcribing a language of the present invention, and specifically the claimed compact set of phonetic alphabets includes a reduced text-to-speech phonetics set.

In this case, the Examiner attempts to combine and to render various dependent claim elements obvious. It is well settled that "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." Although the suggestion to achieve the claimed invention may be found either explicitly or implicitly within the references themselves, there must be some evidence that the skilled artisan would select certain elements from the prior art references and combine them in the manner claimed.⁴ That is, generalizations about the specific teachings of references are insufficient to support a determination of obviousness.

² *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598-99 (Fed. Cir. 1988).

³ *Id.*

⁴ *Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1372, 56 U.S.P.Q.2d 1065, 1073 (Fed. Cir. 2000) (holding that without specific evidence to modify the teachings of prior art references, the obviousness determination, based upon such modified references, is improper).

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the reference."⁵ In other words, the prior art *itself* must suggest the desirability of the modification.⁶ Here, the Examiner has pointed to no particular teaching, suggestion or motivation in *Bordeaux*, *Shu*, or *Selounai*, *Neti*, *Buth* or *Jeppesen* to accomplish acoustic transcription of speech using an orthographic system comprising a compact set of phonetics. Furthermore, the Examiner has pointed to no teaching in the cited references of a system for acoustic transcription of speech that includes a compact set of phonetics. Still further, the Examiner has pointed to no teaching in the cited references of a system for acoustic transcription of speech that includes a reduced text-to-speech phonetics set. Accordingly, Examiner's rejection of the claims of the present invention as obvious over the cited references is improper.

Moreover, when determining the issue of obviousness, the Examiner must consider the claimed invention *as a whole*. In other words, the Examiner cannot use hindsight reconstruction to render the present invention obvious. The fact that the Examiner had to pick and choose discrete portions from each of *six* different references to render the claims of the present invention obvious shows that the invention would not have been obvious to a person of ordinary skill in the art at the time the invention was made. That is, the Examiner used the Applicant's disclosure as a blueprint to render the present invention obvious. Such hindsight reconstruction is certainly improper.⁷ Accordingly, all pending claims are patentable.

⁵ *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q.2d 1125, 1127 (Fed. Cir. 1984).

⁶ *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 U.S.P.Q.2d 1021, 1024 (Fed. Cir. 1984).

⁷ *In re Rouffet*, 149 F.3d at 1357, 47 U.S.P.Q.2d at 1457.

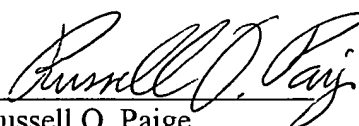
1. Allowable Subject Matter

The examiner has indicated that dependent claims 6 and 7 contain allowable subject matter when combined with independent claim 1. Independent Claims 1, 12 and 19 have been amended to incorporate the allowable subject matter of claim 6.

E. Conclusion

Because (i) *Bordeaux, Shu, Selounai, Neti, Buth* or *Jeppesen*, either individually or in combination, fail to disclose all of the elements of claims 1, 9, and 22 as currently presented, particularly the elements that relate to the compact model for acoustically transcribing a language, and (ii) because the Examiner has not pointed to any portion of *Bordeaux, Shu, Selounai, Neti, Buth* or *Jeppesen*, that suggests modifying any of those references to produce the claimed invention, the pending claims are patentable in view of the three cited references. Accordingly, Applicant respectfully requests reversal of the rejection of claims 1-20 over the cited references, and asks that the claims promptly be permitted to issue.

Respectfully submitted,

By: 
Russell O. Paige
(Reg. No. 40,758)

Dated: March 23, 2004